

REMARKS

The instant Amendment was carefully drawn to avoid the introduction of new matter, or to require a new search. The Amendment responds to each point raised in the Final Rejection of December 9, 2009; and, at the very least, advances the prosecution of the application. Entry of the (proposed) Amendment, and careful consideration thereof, is clearly warranted.

Turning to the claims of record, claims 1-15 are presented for consideration on their merits. Independent claims 1, 12 and 15 have been amended. Independent claims 13 and 14 have been revised extensively and converted to claims 13 and 14, which are dependent on claim 12.

The concluding clause in claim 1 now provides that the safety tab (60) prevents a cutting edge of the blade from becoming exposed. The phrase "adapted to" has been deleted from the claim so that the concluding clause provides a positive limitation on the claim.

Claims 2-11 are unchanged.

Independent claim 12 clarifies that the guard (11) moves relative to the blade (10) between an extended position and a retracted position, the guard extending about the cutting edge of the blade (10) when at the extended position and the blade (10) being exposed when the guard is moved to the retracted position. Claim 12 also clarifies that the anti-lift means comprises a rib (100) that extends along the longitudinal axis of the handle in line with the finger (91) and that the rib is located within a recess (97) on one side of the handle. The rib (100) extending through the elongate recess (71) in the guard (11) on retraction and extension of the guard.

Claims 13 and 14, as currently amended, are dependent on claim 12. Claim 13 stresses that peg (75) abuts against stop (76) in handle (73) when guard (72) is fully retracted; see FIGS. 22-25, and note pages 14-23.

Claim 14 recites the structural relationships, shown in FIGS. 26-29, that provide a positive temporary locking of the guard, when in the extended and retracted positions. The arrangement includes a location means, such as a locking bump (80) on the handle and the recess, or location hole (82) on guard (83), and produces an audible click that assures the surgeon that the guard is fully extended, or completely retracted.

Independent claim 15 which defines applicant's invention in different terms clarifies that longitudinal rib (100) is located within a recess (97) and that longitudinal rib (100) extends through the longitudinal recess (71) in the guard (11).

In clause (2) of the Final Rejection, the Examiner rejected claims 13-15 under 35 USC §102(b) as being anticipated by Herbert et al (U.S. 5,868,711). In particular, the Examiner asserts that Herbert et al discloses a handle (100) having a rib (top edge of handle) and that the guard (200) contains a longitudinal recess (205), whereby the longitudinal rib extends into the longitudinal recess of the guard.

Applicant submits that claims 13-15, as proposed to be amended, are novel and non-obvious in view of Herbert et al.

Amended claim 12, on which claims 13 and 14 depend, recites a safety blade assembly comprising:

"an anti-lift means to reduce the blade guard from lifting relative to the handle when the guard is moved between the extended and retracted positions";

"the anti-lift means comprising an elongate recess in the guard and a rib located within a recess on one side of the handle, the rib extending along the longitudinal axis of the handle and in line with the finger, the rib extending through the elongated recess in the guard upon retraction and extension of the guard " (emphasis added).

It is submitted that Herbert et al does not teach, or even contemplate, the anti-lift means of applicant's amended claim 12. In particular, the top edge of handle (100) in Herbert, which the Examiner asserts forms a rib, is not located on one side of the handle within a recess, nor does the rib (top edge of handle (100)) extend through elongate recess (205) upon retraction and extension of the guard.

Claim 15 has also been amended to clarify that the rib is located within a recess on one side of the handle and that the rib extends through the longitudinal recess in the guard.

Accordingly, applicant's safety scalpel blade assembly, as expressed in claims 12-15, is distinguished from known scalpel blade assemblies on this basis, and represents a major advance over known scalpel blade assemblies.

The Examiner rejected claims 1-8 and 12 under 35 USC §103(a) in the Final Rejection of December 9, 2008, as being unpatentable over Kiehne (WO 01/05312) in view of Gringer (U.S. Patent 6,085,607).

As stated above, applicant has deleted the phrase "adapted to" from the concluding clause of claim 1 to provide the positive limitation that the safety tab (60) prevents a cutting edge of the blade from becoming exposed. Also, the penultimate clause of claim 1 sets forth a specific location for the tab.

The Examiner concedes that Kiehne fails to disclose "a removable tab on the guard having a portion which can be gripped by a person..." The Examiner then asserts that Gringer teaches a removable tab (or extension) that can be gripped by a person... and that the removable tab limits the movement of the blade while the tab is in place (emphasis added).

First, there is no teaching, or suggestion, that the disclosures of Kiehne (directed to a safety scalpel) and Gringer (directed to a utility knife with a snap off carrier, but no guard for the blade) could be combined.

Second, Gringer discloses a retractable utility knife with a blade carrier having a molded return spring. The blade moves within a molded plastic housing. A major component of applicant's safety scalpel, i.e., the guard that coacts with the conventional scalpel blade, is not present in Gringer.

Third, and perhaps most significantly, tab 76 on extension 74 at the forward end 78 of carrier body 68, as shown in FIGS. 50-52 of Gringer, does not prevent the cutting edge of the blade from becoming exposed. As noted in column 9, lines 19-38 of Gringer, extension 74 prevents further forward movement of the blade carrier. Extension 74, however always allows some portion to be exposed; column 9, line 34, specifically mentions that 0.25 inches of the blade are exposed. When the extension 74 is snapped off the blade carrier in Gringer, the blade may then be fully extended, as noted in column 9, lines 35-57. Thus, Gringer does not disclose a tab on the guard... that prevents a cutting edge from becoming exposed, and, in essence, "teaches away" from the safety scalpel arrangement expressed, in claim 1, as presently constituted.

The British patent to Abidin discloses a surgical scalpel (10) provided with a retractable guard (11) for its cutting blade (12). The guard is mounted on handle (24) of the scalpel,

for sliding movement on the handle, between a covered, and a retracted position in which the blade is exposed (see FIGS. 3b and 5, for example) with the use of only one hand. Detent means (28, 29) lock the blade in the two fixed positions. No tab is disclosed, or suggested, that prevents a cutting edge from becoming exposed..., as expressed in applicant's claim 1. Thus, the combination of the disclosures of Kiehne, Gringer, and/or Abidin, assuming *arguendo* that such combination is feasible, still does not anticipate, or render obvious, applicant's unique protective tab located on the guard of the scalpel assembly.

Dependent claims 2-11 set forth further, specific features of applicant's safety scalpel blade assembly; note, for example, head portion (61), tail portion (62) and slot (17) in claim 2. Note also first and second necks (63, 64) in claim 4; safety catch (75) in claim 9; bump (80) and hole (82) in claim 9, etc.

Amended claim 12 recites:

"[that] the guard [moves] relative to the blade between an extended position, wherein the guard extends about the cutting edge of the blade, and a retracted position, wherein the blade is exposed"; and

"an anti-lift means to reduce the blade guard from lifting relative to the handle when the guard is moved between the extended and retracted positions, the anti-lift means comprising an elongate recess in the guard and a rib located within a recess on one side of the handle, the rib extending along the longitudinal axis of the handle and in line with the finger, the rib extending through the elongated recess in the guard upon retraction and extension of the guard".

It is submitted that Gringer does not disclose or suggest a blade guard that can move relative to the blade between extended and retracted positions, at which positions the blade is either surrounded by the guard or exposed. In fact, Gringer expressly "teaches away" from any such assembly. Further, Kiehne does not disclose or suggest an anti-lift means as described in amended claim 12. Accordingly, a skilled artisan would not have combined Gringer and Kiehne to arrive at the safety scalpel assembly of amended claim 12. Thus, independent claims 1 and 12, and dependent claims 2-10 and 13-14 are clearly distinguishable over known surgical scalpels, and are patentable in content.

For the several reasons noted above, the instant (proposed) Amendment should be entered into the file of the pending application, and accorded prompt, and favorable, consideration. If the Examiner believes that a telephone conversation, or personal interview would resolve any issue in contest, or advance prosecution in a meaningful manner, the Examiner is invited to contact the undersigned attorney at 703.415.0100.

Respectfully submitted,

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Date

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